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In re Application of:) Art Unit: 1647
KOPCHICK, et al.)
Serial No.: 08/488,164) Examiner: SAOUD, C.
Filed: June 7, 1995) Washington, D.C.
For: DNA ENCODING GROWTH) October 17, 2001
HORMONE ANTAGONISTS) Docket No.: KOPCHICK=1E
)

SUBSTITUTE ELECTION WITH TRAVERSE

Honorable Commissioner of Patents
Washington, D.C. 20231

S i r :

In response to the communication mailed October 3, 2001, we respond as follows:

In response to the group restriction, we again elect group I with traverse.

As between groups (I) and (II), the subject matter are related as subcombination to combination. The patentability of the combination (the animal) is based on that of the subcombination (the DNA). So the I/II restriction is improper. See MPEP 806.05(c), especially part (II).

As between groups (II) and (III), it appears from the "conclusion" that the Examiner agrees that there is allowable subject matter. Hence pursuant to MPEP 809.02, the claims of group (III) which are dependent on allowable claims of group (I) must be rejoined.

In response to the species restriction, Applicants elect HGH (G120K) with traverse. Claims 10-37, 40-46, 62, 63, 65-74, 78, 80-85, 88-99, 101, and 106-109 read on the elected species.

The species restriction is first traversed on the grounds that generic claims are allowable. This is a proper ground of traversal, see MPEP §809.02(b), 809.02(c)(B)(1), 809.02(e), and 809.03(A).

The species restriction is also traversed on the ground of lack of undue burden. Claims 10-62, covering many different GH mutant sequences, were presented on March 14, 1997. Claims 10-44

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and 62, drawn to the DNA and transformed cells (essentially the present group I), were examined on their merits on July 22, 1997, without any species restriction. This implies that the Examiner searched not only the generic subject matter, but also all claims directed to subgenera or species.

Claims 63 and 64 were added January 22, 1998, and claims 65-73 on November 10, 1998. These new claims were likewise all examined on their merits, on November 6, 1998.

Claim 74 was added November 8, 1999. A third, complete action on the merits followed (January 31, 2000).

Claims 75-106 were added on July 28, 2000. Once again, all of the new claims were examined, see October 24, 2000 supplemental office action.

Subsequently, Applicants filed a response (on November 29, 2000) which did not amend or cancel any claims. Nonetheless, the instant action all of a sudden finds grounds for imposing a species, restriction requirement, even though all group I claims have been examined on the merits at least once, and some have been examined as many as four times! Hence, there is no "serious burden" in examining all of these claims. See MPEP §803(B).

The species restriction is also traversed on the grounds that the species are "related" by virtue of their sequence similarity and common biological activity. See MPEP §806.04(b), 808.01(a), and 808.02. However, we do not make any admission of lack of patentable distinctness between species.

Respectfully submitted,

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